

Applicants: Kiran K. Chada et al.
Serial No.: 10/630,423
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Remarks

Claims 1-15, 47, 102-103 and 116 are pending and under examination. Applicants have not cancelled, amended or added any claims herein.

Restriction Requirement Under 35 U.S.C. §121

The August 27, 2007 Office Action imposes a restriction requirement under 35 U.S.C. §121 of the claims to one of the eleven (XI) groups listed hereinbelow. Applicants note that, contrary to the Examiner's statement that claims 1-116 are pending, only claims 1-15, 47, 102-103 and 116 are pending in light of the Preliminary Amendment filed by applicants on July 29, 2003 in connection with the above-identified application.

- I. Claims 1-9, drawn to a method of identifying genes that are over-expressed in adipose tissue as compared to non-adipose tissue comprising differential gene expression;
- II. Claims 10-21, 31, 47-57, 67, 82-91 and 101, drawn to a nucleic acid, a vector comprising the same, a host cell comprising the vector and a method of making a protein using a said host cell;
- III. Claims 22-23, 58-59 and 92-93, drawn to a polypeptide;
- IV. Claims 24, 60, 94, drawn to an antibody;
- V. Claims 25-26, 61-62, 95-96, drawn to a method for treatment of a subject in need of enhance activity or expression of a polypeptide;

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VI. Claims 25-26, 61-62, 95-96, drawn to a method for treatment of a subject in need of decreased activity or expression of a polypeptide;

VII. Claims 27, 63, 97, drawn to a method for diagnosing a susceptibility to diabetes or obesity in a subject comprising determining the presence or absence of a mutation in the nucleic acid encoding a protein;

VIII. Claims 28, 32-44, 64, 68-80, 98, 103-115, as drawn to a method for identifying compounds which antagonize a polypeptide comprising contacting a candidate compound with a cell expressing said polypeptide and measuring the binding, stimulation or inhibition by said compound to the polypeptide;

IX. Claims 29, 46, 65, 81, 99, 116, as drawn to an agonist to a polypeptide;

X. Claims 30, 46, 66, 81, 100, 116, as drawn to an antagonist to a polypeptide; and

XI. Claims 45, 102, 104-115, as drawn to a bioassay for identifying compounds which prevents adipose accumulation comprising exposing a eukaryotic cell that expresses a polypeptide to a compound and monitoring the cell to change in activity which is predictive of adipose accumulation.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's claim group I, i.e. claims 1-9 drawn to a method of identifying genes that are over-expressed in adipose tissue as compared to non-adipose tissue comprising differential gene

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expression.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-XI are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect...". The claims of Group I-XI are related in that they are drawn to similar compounds, compositions, and methods of use. All of the methods are directed to adipocyte-specific nucleic acids, polypeptides and methods relating thereto.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

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Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I-XI would likely identify art for the other Groups. Since there is no serious burden on the Examiner to examine Groups I-XI in the subject application, the Examiner must examine the entire application on the merits. In particular, applicant notes that a search of the prior art with regard to group II would identify art for group I and vice versa.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine the pending claims on the merits.

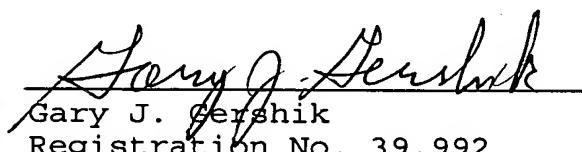
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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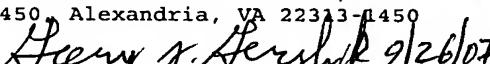
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No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125

Respectfully submitted,


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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Gary J. Gershik Date
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